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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,800	02/23/2004	Fausto Pinna	249175US0	5473
22850	7590	10/04/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			LEWIS, KIM M	
			ART UNIT	PAPER NUMBER
			3743	

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/782,800

Applicant(s)

PINNA ET AL.

Examiner

Kim M. Lewis

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6,7 and 9-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6,7 and 10-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Detailed Action.

DETAILED ACTION

Response to Amendment

The amendment filed on 7/12/05 has been received and made of record. As requested claims 2, 5 and 8 have been canceled. Claims 1, 3, 4, 6, 7, 9-15 are pending.

Allowable Subject Matter

The indicated allowability of claim 2 is withdrawn in view of the newly discovered reference(s) to U.S. Patent Application Publication 2003/0008011. Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 3, 4, 6, 7 and 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,480,717 ("Kundel") in view of U.S. Patent Application Publication 2003/0008011 ("Mershon").

As regards claims 1, Kundel discloses hydrogel laminate bandages and composites, thereby disclosing pads (col. 6, lines 14-17), for application to the human skin, to develop a decongestant, cosmetic and/or pharmaceutical action (col. 4, lines 35-40), comprising a flexible porous support (col. 5, line 62-col. 6, lines 7), on at least one surface of which is applied a layer of gel comprising between 50% and 77% of water, between 6.5% and 44% of a dermatologically compatible polymer (col. 4, lines 51-54), between 0% and 10% of a substance of plant origin comprising essential oils and aromatic extracts; and between 0% and 10% of at least one dermatologically compatible component chosen from the group consisting of soothing, skin repairing, cicatrising, anti-inflammatory antiseptic and bactericidal substances, the percentages being by weight.

Kundel fails to teach the gel comprises between 0.01% and 5.2% of an alkaline or alkaline earth metal tetraborate, the percentages being by weight. Mershon, however, discloses that it is known to use a tetraborate (borate salts) to thicken (gel) polyvinyl alcohol [0012]. As such, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add a tetraborate to the polyvinyl alcohol, when used, in order to thicken or cause the polyvinyl alcohol solution to gel.

The applicant should note that the plant origin substance and the dermatologically compatible component do not necessarily have to be present in the prior art in order to meet the claim limitations since they are both present in the range of 0% to 10%.

The applicant should also note that auxillary agents may also be present in the hydrogel, e.g., color stabilizers or coloring agents.

As regards claims 3, 4, 6, 7, 9 and 10, Kundel fails to explicitly teach the thickness and density of the support (reinforcement), the percent by weight of the auxillary agent present in the gel, and the percent by weight of a plant origin substance present in the gel.

The examiner, however, contends that the claims do not appear to contain any additional features, which in combination with the features of any claim to which they refer, add anything novel. As such, absent a critical teaching and/or a showing of unexpected results, the limitations present in claims 3-10 are considered obvious design choices to one having ordinary skill in the art, and the addition of such to a prior art device would have been routine skill in the art.

As regards claims 11-12 and 14-15, Kundel fails to explicitly disclose a cosmetic, a decongestant, a decongestant nasal patch or a pharmaceutical eye patch. However, discloses that medicaments such as antibacterial agent can be incorporated into the hydrogel. The examiner contends that it would have been obvious to one having ordinary skill in the art at the time the invention was made to add to the hydrogel, decongestants and cosmetics, as well as other pharmaceutical agents for use on the body in order to treat the user. It would also have been obvious to one having ordinary skill in the art at the time the invention was made to place the device on any portion of the body (*i.e.*, eye, nose, hand, chest arm, etc.) needing treatment. It is important to note that when the device is placed on the eye, the device is an eye patch. Also, when the device comprises a decongestant and it is placed on the nose, it is a nasal patch.


As regards claim 13, the disclosed device of Kundel is a pharmaceutical comprising the pad as outlined in the rejection of claim 1 above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim M. Lewis whose telephone number is (571) 272-4796. The examiner can normally be reached on Mondays to Thursdays from 5:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A. Bennett, can be reached on (571) 272-4791. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kim M. Lewis
Primary Examiner
Art Unit 3743

kml
October 3, 2005